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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/647,279	07/18/2001	Kazumi Iijima	K0208-013	5027

23723 7590 12/16/2003

Patterson Belknap Webb & Tyler, LLP  
Attention: I.P. Docketing  
1133 Avenue of the Americas  
New York, NY 10036

EXAMINER
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AUGHENBAUGH, WALTER

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 12/16/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/647,279

Applicant(s)

IIJIMA, KAZUMI

Examiner

Walter B Aughenbaugh

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--Th MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 19 November 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY [check either a) or b)]**

- a) ☒ The period for reply expires 6 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☐ The a) ☐ affidavit, b) ☐ exhibit, or c) ☐ request for reconsideration has been considered but does NOT place the application in condition for allowance because: \_\_\_\_\_.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1-5.Claim(s) withdrawn from consideration: 6.

8. ☐ The drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_.
10. ☐ Other: \_\_\_\_\_

## **ADVISORY ACTION**

### ***Acknowledgement of Applicant's Amendments***

1. The amendments made in claims 1, 3 and 5 in Applicant's After Final Amendment filed November 19, 2003 (Paper 11) have not been entered due to the fact that they raise new issues that would require further consideration and/or search. The limitation "pre-filled" is a new limitation that raises new issues that would require further consideration and/or search. Furthermore, the amendments made in the last six lines of claim 1 introduce new structural limitations that raise new issues that would require further consideration and/or search.

### ***ANSWERS TO APPLICANTS ARGUMENTS***

2. Applicant's arguments regarding the 35 U.S.C. 102 rejection of claim 1 as anticipated by Moncada et al. made of record in paragraph 9 of Paper 9 have been fully considered but are not persuasive. In response to Applicant's argument on the top of page 4 of Paper 11 that "adapter 80 therefore does not extend from the nozzle portion of the syringe barrel", the limitations on which the Applicant relies (i.e. the adapter extending from the nozzle portion) are not stated in the claims. It is the claims that define the claimed invention, and it is the claims, not specifications that are anticipated or unpatentable. *Constant v. Advanced Micro-Devices Inc.*, 7 USPQ2d 1064. Applicant also argues that the luer lock connector taught by Moncada et al. is not "formed in the nozzle portion" but this limitation was newly added to claim 1 in Paper 11 and has not been entered for the reasons discussed above in paragraph 1 of this Advisory Action.

Applicant then argues that Moncada et al. doesn't teach that all or part of an inner surface of the luer lock portion has a roughened surface; Applicant seems to have neglected the sentence prior to the sentence including the statement that "all or part of an inner surface of the luer lock

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portion (the combination of items 108 and 116 and the space between items 108 and 116, Fig. 5) has a roughened surface” that explains the reason why Moncada et al. teach that all or part of an inner surface of the luer lock portion has a roughened surface: “Moncada et al. teach that the outside surfaces of the ears (item 34) include teeth (item 48) and that teeth or any other type of roughened surface are formed on the rear surface (item 50, Fig. 1) of the ears (item 34) (col. 4, lines 42-60 and Fig. 1 and 2)”. Since the outside surfaces of the ears are part of the inner surface of the luer lock portion, Moncada et al. teach that all or part of an inner surface of the luer lock portion has a roughened surface.

3. Applicant’s arguments regarding the 35 U.S.C. 103 rejection of claim 4 over Moncada et al. in view of Porfano et al. made of record in paragraph 11 of Paper 9 have been fully considered but are not persuasive. Applicant argues that “the technical field and purpose of Porfano et al. differ from that of the claimed invention on pages 4-5 of Paper 11. As Applicant acknowledges on page 5 of Paper 11, and as is made of record in paragraph 11 of Paper 9, the Porfano et al. deals with plastic syringe barrels (it is stated in paragraph 11 of Paper 9 that “Porfano et al. teach that cyclic polyolefin copolymers are suitable plastics to use as the syringe barrel material since cyclic polyolefin copolymers typically do not require a clarifying agent (col. 6, lines 46-48)”). One of ordinary skill in the art would have consulted the Porfano et al. reference that teaches a suitable material for plastic syringe barrels in order to determine the type of material to use for the plastic syringe barrel of Moncada et al.

4. Applicant’s arguments regarding the 35 U.S.C. 103 rejection of claim 3 over Moncada et al. made of record in paragraph 10 of Paper 9 have been fully considered but are not persuasive.

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Applicant argues that Moncada et al. does not teach that “any frictional engaging means (including teeth or a roughened surface, col. 4, lines 45-50) may be positioned at any other location along the length of the adapter (col. 6, lines 19-23)” as the Office Action (Paper 9) states in paragraph 10. The cited passage in col. 6 states that “the threaded engaging means or other engaging means may be positioned at any other location along the length of the adapter”, and the cited passage from col. 4 plainly states that the teeth are “for increased frictional engagement between the ears 34 and a cooperating female Luer lock portion”; Moncada et al. clearly consider the teeth to be an engaging means- not the threaded engaging means, but an engaging means that falls within the “other engaging means” genus that is taught at col. 6, line 21 of Moncada et al.

5. Applicant’s arguments regarding the 35 U.S.C. 103 rejection of claim 5 over Moncada et al. in view of Lampkin made of record in paragraph 12 of Paper 9 have been fully considered but are not persuasive. Applicant argues that the purpose of the roughened area Lampkin is “entirely different” than the purpose of the claimed invention, but the purpose of the roughened area of Lampkin is irrelevant; Lampkin teaches a method by which a roughened area is formed. One of ordinary skill in the art would have consulted Lampkin for a method of forming a roughened surface on a plastic syringe since Lampkin teaches a syringe having a roughened surface.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Walter B. Aughenbaugh whose telephone number is 703-305-4511. The examiner can normally be reached on Monday-Thursday from 9:00am to 6:00pm and on alternate Fridays from 9:00am to 5:00pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon, can be reached on 703-308-4251. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

wba  
12/15/03

WBA

  
HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

12/15/03